

REMARKS/ARGUMENTS

The claims are 2-6, 10 and 12, with claims 8 and 11 having been withdrawn from consideration by the Examiner as being directed to a non-elected invention.

Reconsideration is expressly requested.

The Examiner has taken the position that newly submitted claim 11 and amended claim 8 as presented in the Amendment filed on July 8, 2010 are directed to an invention that is independent or distinct from the invention originally claimed because the previously examined claims were for the device of a profiled cover and the newly submitted invention is for the method of producing the floor covering device. In the Examiner's view, since the Applicant has already received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Applicant respectfully disagrees with the Examiner's position. In particular, contrary to the Examiner's assertion, Applicant's claims as originally filed included both claims

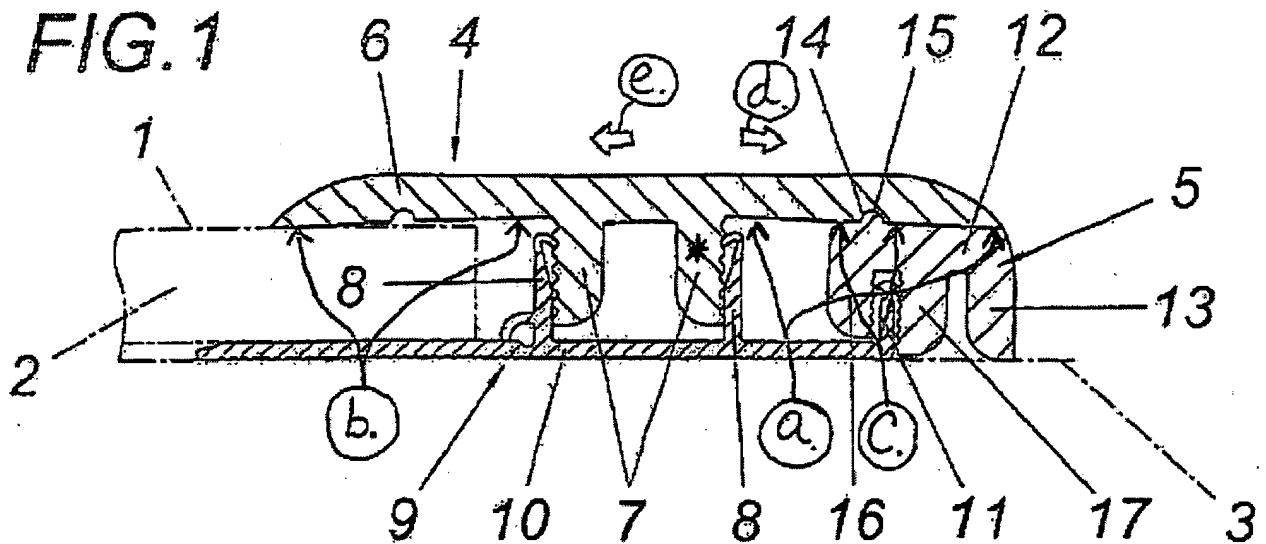
directed to the device and claims directed to the method of producing a profiled cover. Moreover, the Examiner has already issued numerous Office Actions examining both types of claims. In view of the foregoing, Applicant respectfully requests that the restriction be withdrawn and that claims 8 and 11 be re-joined and examined on the merits.

Claims 10 and 12 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement with respect to the features a. - e. set forth on page 3 of the Office Action. In particular, the Examiner has taken the position that the following items are not supported by the disclosure: (a) a first contact surface; (b) a second contact surface; (c) a groove section; (d) the first contact surface extending past the clamping web; and (e) the second contact surface extending past the clamping web.

The rejections of claims 10 and 12 under 35 U.S.C. § 112, first paragraph are respectfully traversed.

Applicant submits that the features denoted by the Examiner as a. - e. are clearly supported, *inter alia*, in FIG. 1 of the disclosure as filed.

Reproduced below is an illustrative drawing wherein FIG. 1 of Applicant's disclosure as filed has been annotated to indicate the subject features.



Specifically, FIG. 1 of the drawings shows the following:

- (1) a first contact surface "a." on the underside of covering flange 6 in the area directly above and near the compensating strip 5, which is shown in the above annotated FIG. 1 as including all of the area in

between the two arrows shown in FIG. 1 that extend from reference character "a.";

- (2) a second contact surface "b." on the underside of covering flange 6 in the area directly above and near floor covering 2, which is shown in the above annotated FIG. 1 as including all of the area in between the two arrows shown in FIG. 1 that extend from reference character "b.";
- (3) a groove section "c." in the covering flange 6 as a portion of the first contact surface "a." described above and including longitudinal groove 14 and the flat areas of the underside of the covering flange 6 immediately adjacent the longitudinal groove 14, which is shown in the above annotated FIG. 1 as including all of the area in between the two arrows shown in FIG. 1 that extend from reference character "c.";
- (4) the first contact surface "a." described above extending past the clamping web 7, which is further toward the right of FIG. 1 and is labeled with "*", on

a first side of the profiled cover 4 in the direction labeled as "d."; and

- (5) the second contact surface "b." described above extending past this clamping web 7* on a second side of the profiled cover 4 in the direction labeled as "e."

Accordingly, it is respectfully submitted that Applicant's claims 10 and 12 fully comply with the written description requirement of 35 U.S.C. § 112, first paragraph, and it is respectfully requested that the Examiner's rejection of the claims on this basis be withdrawn.

The Examiner indicated that claims 5 and 6 contain allowable subject matter; however, the remaining claims were rejected on the basis of the prior art. Specifically, claims 10 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stanchfield U.S. Patent No. 6,860,074*. The remaining rejected claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer U.S. Design Patent No. D 542,941* (claims 2-3) and over *Stanchfield* and *Neuhofer U.S. Design Patent No. D 542,941* and further in view of *Kemper U.S. Patent No. 6,345,480* (claim 4).

Applicant respectfully traverses these rejections in view of the following remarks.

As set forth in Applicant's July 8, 2010 Amendment, Applicant's invention as set forth in claim 10 provides a floor covering device that can be supported flat over both a floor area with an elevated flat floor cover segment and over a compensating strip having a tongue. In particular, Applicant's floor covering device as recited in claim 10, and shown for example in Applicant's FIG. 1, has a covering flange 6 of the profiled cover 4 that on both sides of clamping web 7 has a contact surface on its underside for flat installation on a floor covering, i.e. forms a contact surface for a floor covering. Moreover, Applicant's invention as set forth in claim 12 provides a floor covering device that has all of the features of the profiled cover of Applicant's claim 10 and that can be used with a compensating strip and fixture to provide the benefits achieved by Applicant's floor covering device as recited in claim 10.

Contrary to the Examiner's interpretation, *Stanchfield* does not teach in FIG. 2, that the arm 12 of the floor covering is flat over the floor 24, 25 of which it covers. It is respectfully submitted that the Examiner's assertion is incorrect

because as shown in FIG. 2 of *Stanchfield*, it is not the arm 12 of the molding 11 that lies flat against the floor covering on the side of the lower floor covering 25, but rather the leveling block 40 that lies flat against the floor covering 25. It is fundamentally impossible for the part of the arm 12 that forms the tongue 18 to lie flat against the floor covering.

Accordingly, *Stanchfield* fails to disclose a profiled cover having first and second contact surfaces on an underside of the profiled cover and on both sides of the clamping web that allow flat support of the profiled cover on floor coverings with substantially completely flat top surfaces. The molding device 11 of *Stanchfield* would not be able to be installed on each side of foot 16 on a floor covering with a substantially completely flat top surface, because the tab 18 would interfere so that most of arm 12 of the molding 11 would be elevated above the substantially completely flat top surface and only the tab 18 would lie flat on the substantially completely flat top surface. The narrow tab 18 would thereby support the entire weight of the arm or covering flange which could cause the narrow tab 18 to prematurely be broken off the arm or covering flange.

In contrast, Applicant's floor covering device as recited in claims 10 and 12 allows the profiled cover to be supported flat over either of a compensating strip having a tongue and an elevated floor covering segment having a substantially completely flat top surface.

It is also respectfully submitted that, contrary to the Examiner's position, Applicant's floor covering device as recited in independent claims 10 and 12 does not merely constitute a mere reversal of the working parts of the floor molding of *Stanchfield* because of those reasons provided previously in the Amendments and Responses already submitted by Applicant for this application.

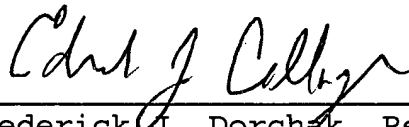
Moreover, neither of *Neuhofer, Jr. U.S. D542,942* and *Kemper et al. U.S. Patent No. 6,345,480* remedy the deficiencies of *Stanchfield* with respect to Applicant's claims 10 or 12, because neither of *Neuhofer, Jr.* and *Kemper et al.* discloses a tongue-and-groove joint as recited in Applicant's claim 10 and neither provides the benefits provided by Applicant's floor covering device as recited in claims 10 and 12. Each of *Neuhofer, Jr.* and *Kemper et al.* fails to disclose any tongue or groove on either of

the profiled cover and the compensating strip that interacts with the other of the profiled cover and the compensating strip.

Accordingly, it is respectfully submitted that Applicant's claim 10, together with claims 2-6 which depend thereon, and claim 12 are patentable over the prior art references cited by the Examiner.

In view of the foregoing, withdrawal of the final action and allowance of this application are respectfully requested.

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 17, 2010.


Amy Klein